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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,431	01/22/2004	Lutz Biedermann	7948-17	6801
7590	10/11/2006			EXAMINER PHILOGENE, PEDRO
Barry E. Bretschneider Morrison & Foerster LLP 1650 Tysons Boulevard Suite 300 McLean, VA 22102			ART UNIT 3733	PAPER NUMBER

DATE MAILED: 10/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

N1

Office Action Summary	Application No.	Applicant(s)	
	10/763,431	BIEDERMANN ET AL.	
	Examiner	Art Unit	
	Pedro Philogene	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 January 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 6-10, 12, 13, 17, 18, 20-24, 26-35, 40-42, 61 and 62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 6-10, 12, 13, 17, 18, 20-24, 26-35, 40-42, 61 and 62 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/17/06/24/06, 10/10/05, 12/4/05, 5/10/05</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| | 6) <input type="checkbox"/> Other: _____ |

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 6-10,12-13,17,18, 20-35, 40-42,61-62 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,736,820. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is clear that all the elements of claims 6-10,12,13,17,18,20-35, 40-42,61-62 are to be found in claims 1-8. The difference between claims of the application and claims of the patent lies in the fact that the patent claims include many more elements and are thus much more specific. Thus the invention of claims 6-10,12,13,17,18,20-35,40-42,61-62 of the patent is in effect a "species" of the "generic" invention of claims 1-8. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fe.

Cir. 1993). Since claims of the application are anticipated by the claims of the patent, they are not patentably distinct.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-10,12,13,17,18,20-2161,62 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6, line 5, the passage "said lower end" lacks prior antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6-10, 12,13, 17,18,20-35,40,42,61,62 are rejected under 35 U.S.C. 102(b) as being anticipated by Biedermann et al. (5,443,467).

Biedermann et al disclose a bone fixation assembly comprising a coupling element (5) having an inner surface defining a first bore (7) coaxial with a longitudinal axis and a second bore (8) coaxial with a second longitudinal axis, wherein the first and second longitudinal axes intersect and are in communication with each other; the

coupling element including a seat; as best seen in FIG.1, adjacent the lower end of the coupling element said seat being defined by the inner surface of the coupling element; and an anchoring element (1) assembled with the coupling element , the anchoring element having a first end for insertion into bone and a head spaced from the first end , the head being in contact with the seat of the coupling element; as best seen in FIG.4. a U-shaped rod receiving opening (6) extending from the upper and toward the lower end of the coupling element adapted to receive an orthopedic stabilizing rod (16); a locking element (13,14).

Claims 6-10, 12,13, 17,18,20-35,40,42,61,62 are rejected under 35 U.S.C. 102(b) as being anticipated by Morrison et al. (5,891,145).

Morrison et al disclose a bone fixation assembly comprising a coupling element (30) having an inner surface defining a first bore (34) coaxial with a longitudinal axis (38) and a second bore coaxial with a second longitudinal axis (45), wherein the first and second longitudinal axes intersect and are in communication with each other; the coupling element including a seat; as best seen in FIG.4, adjacent the lower end of the coupling element said seat being defined by the inner surface of the coupling element; as set forth in column 5, lines 40-46, and an anchoring element (20) assembled with the coupling element , the anchoring element having a first end for insertion into bone and a head spaced from the first end , the head being in contact with the seat of the coupling element; as best seen in FIG.4; a U-shaped rod receiving opening (6) extending from the upper and toward the lower end of the coupling element adapted to receive an orthopedic stabilizing rod (80); a locking element (70).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5,891,145 Morrison et al. 4-1999

6,139,550 Michelson 10-2000

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene
September 27, 2006



PEDRO PHILOGENE
PRIMARY EXAMINER